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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,958	03/02/2004	Mark J. Hampden-Smith	41890-01693	2158

25231 7590 06/26/2006

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,958

Applicant(s)

HAMPDEN-SMITH ET AL.

Examiner

George P. Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 143-153 and 168-172 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 143-153 and 168-172 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. The Preliminary Amendment filed January 12, 2005 (with Certificate of Mailing dated January 5, 2005) has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 143, 170 and 171 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz (U.S. Patent 3,673,092).

Column 7, lines 6-50 of Dietz discloses forming a paste including particles 2-3 microns in size and comprising 17.6% Pd, along with various dielectric oxides including titanium oxide, and a liquid organic vehicle. The combined pastes are fired at 875 degrees C to form a coating onto a ceramic substrate. With regard to claim 143 as amended, nothing in Dietz would indicate the presence of any substantial amount of alkaline earth metals in the particles of that reference.

With regard to claim 170, note that Dietz column 6, line 13 indicates metallic phases containing silver were known to be equivalent to those used in the embodiment of column 7 of Dietz.

Dietz does not disclose the crystallite size recited in instant claim 143 or the oxidation resistance value (under thermogravimetric analysis or any other method) recited in instant claims 143 and 171. These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) With respect to crystallite size, the Dietz method does not limit the crystallite size and would include processes performed using particles having the presently claimed crystallite size.

Thus, this aspect of the claimed invention is held to be within the purview of the process disclosed by Dietz.

b) The oxidation resistance of a material would be largely determined by the composition and physical structure of that material. Because these parameters may be the same in either the prior art or the claimed process, no patentable distinction is seen in this aspect of the invention.

Thus, a prima facie case of obviousness is established between the disclosure of Dietz and the presently claimed invention.

4. Claims 143-153 and 168-172 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent 7,004,994 (which issued from Application Serial no. 10/774,791).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and the '791 claims are directed to a process of forming films on a substrate by firing pastes including small noble metal particles of a certain size and distribution, and further including many substantially identical limitations in their respective dependent claims; compare instant claims 145-152 with '791 claims 4-11. The '791 claims involve making a silver-containing film, as opposed to making a palladium-containing film in the instant claims. However, note that the paste of '791 claim 143 includes not only "particles including silver" but also second particles including palladium. Note also that both the instant claims and the '791 claims employ open language with respect to the composition of the particles, e.g. the claims refer to palladium-containing and silver-containing films and particles, and are thus open to the inclusion of additional materials. Thus, no patentable distinction is seen between the process as recited in the '791 claims and that of the instant claims.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. In a response filed April 17, 2006, Applicant alleges that the presently claimed oxidation resistance would not be present in the particles of Dietz. Applicant points to a statement in the previously applied Asada reference that indicates that palladium powder oxidizes easily. Applicant's arguments have been carefully considered, but are not persuasive of patentability because:

a) Applicant has not shown that any particular difference in oxidation resistance exists in the claimed invention versus that of the prior art, i.e. no probative evidence has been presented of any numerical or qualitative difference in oxidation resistance between the two.

b) Even if one looks to Asada for a teaching of oxidation resistance, it is noted that the Tables of Asada disclose specific examples having oxidation resistance levels within the presently claimed range.

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Applicant has requested that consideration of the obviousness-type double patenting rejection be held in abeyance until the indication of otherwise allowable subject matter. To this end, the examiner notes that this rejection is the only rejection currently pending against instant claims 144-153, 168, 169 and 172.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the new central facsimile number, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GPW
June 22, 2006


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700